

## **REMARKS**

### **Introductory Comments:**

Claims 11-20 were examined in the Office Action dated February 28, 2007.

Claims 11-20 were rejected on the grounds of non-statutory obviousness-type double patenting over U.S. Patent No. 6,686,152.

Claims 11-20 were rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over U.S. Patent No. 5,470,705 to Grossman et al. (Grossman) in view of U.S. Patent No. 5,851,770 to Babon et al. (Babon).

### **SUPPORT FOR THE AMENDMENTS**

Claim 11 has been amended to recite that “said eTag reporter of each electrophoretic probe having a negative charge upon release therefrom and said capture agent confers on said undigested electrophoretic probes a positive charge.” Support for the amendment can be found throughout the specification as filed, such as, for example, previously pending claim 13.

Claim 11 has also been amended to add the word “from” so that it recites “electrophoretic probes from the electrophoretic separation.” The amendment corrects for a minor grammatical error.

Claim 13 has been canceled without prejudice or disclaimer.

Accordingly, no new matter has been added by way of this amendment and the entry thereof is respectfully requested.

### Addressing the Examiner's Rejections

#### Rejections of the Claims Under 35 U.S.C. §103(a)

The Examiner rejected claims 11-20 under 35 U.S.C. §103(a) as allegedly being unpatentable over Grossman in view of Babon.

The applicants traverse the rejection. In order for the Office to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references. Second, there must be a reasonable expectation of success. Finally, the prior art references must teach or suggest all the claim limitations. The teachings or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaack*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). The combination of the cited references do not disclose all the elements of the applicants' claims, therefore, a *prima facie* case of obviousness has not been made.

The applicants had also previously suggested that the combination of Grossman and Babon does not disclose a single separation between the undigested electrophoretic probes and the eTag reporters. Babon discloses that a magnetic field is applied to the mixture to separate the reacted from the unreacted material (step e, abstract), and the reacted material is then separated. Babon thus teaches two steps to separate the reacted from the unreacted material. The deficiency of Babon is not cured by Grossman. The Examiner rejected the argument stating that the phrase "comprising" permitted additional steps and the pending claims did not indicate a single separation between the undigested probes and the released eTag reporters.

The phrase “comprising” does permit additional steps. However, all the recited elements of the method claims must be performed. The elements of the pending claim 11 requires **excluding the undigested electrophoretic probes where they migrate in a direction opposite** of that of the eTag reporters that are electrophoretic separated (emphasis added). Thus, the same sample contains the undigested electrophoretic probes and the eTag reporters, and a single separation resolves the two where the released reporters migrate in one direction and the undigested probes migrate in a direction opposite. If the undigested electrophoretic probes were removed from the mixture, then undigested electrophoretic probes would not be present and they could not be excluded from the electrophoretic separation of the eTag reporters. Further, since the same sample contains the undigested electrophoretic probes and the eTag reporters, the independent claim 11 indicates that a single separation step is performed. Thus, the combination of the references does not disclose all the elements of the applicants’ claims.

Further, the Examiner acknowledges that Grossman and Babon “do not explicitly disclose the capture agent which confers on the undigested electrophoretic probes a charge that causes the undigested electrophoretic to migrate upon electrophoretic separation in a direction opposite of that of the e-tag reporters, thereby excluding said undigested electrophoretic probes from the electrophoretic separation of the released e-tag as recited in claim 11.” Nevertheless, the Examiner states that because the dependent claims have the same characteristics as the disclosure of Babon, the capture ligands and agents of claim 11 would have the inherent property claimed in the independent claims.

The applicants had previously requested the Examiner to support the assertion in the form of an Examiner's affidavit in accordance with MPEP 706.02(a). The Examiner stated that an affidavit was not necessary since it would have been obvious from the teachings of Babon “to

exclude the undigested electrophoretic probes from the released eTag reporters via electrophoretic separation.”

The applicants disagree and again request an Examiner's affidavit in accordance with MPEP 706.02(a) in order to maintain the rejection. The elements of claim 11 recite adding to the mixture a capture agent that specifically binds the capture ligands of the electrophoretic probes and confers on the undigested electrophoretic probes a charge that causes the undigested electrophoretic probes to migrate upon electrophoretic separation in a **direction opposite** of that of the eTag reporters (emphasis added). The Examiner is asked to provide evidence that if, for example, a probe had biotin and it was contacted with avidin, then the undigested probes would inherently separate in a direction **opposite** to the digested probes.

Regardless, in order to further prosecution, the applicants have amended the independent claim 11 to recite that eTag reporter of each electrophoretic probe has a negative charge upon release and the capture agent confers on the undigested electrophoretic probes a positive charge. Neither Grossman nor Babon, either alone or in combination, disclose this element of claim 11.

The combination of Grossman and Babon does not disclose all the elements of the claims, and therefore, a *prima facie* case of obviousness has not been presented by the Office. Therefore, the Examiner is respectfully requested to withdraw the rejection.

### **Provisional Rejections of the Claims Under Double Patenting**

Claims 11-20 were provisionally rejected under the judicially created doctrine of obviousness-type double patenting over the claims of U.S. Patent No. 6,686,152. The applicants will consider filing a terminal disclaimer upon indication of allowable subject matter.

## CONCLUSION

Applicants respectfully submit that the claims define an invention that is patentable over the art, and a notice of allowance is earnestly solicited. If the Examiner has any questions concerning this Response, the Examiner is invited to telephone Applicants' representative at (650) 335-7818.

Respectfully submitted,  
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